REMARKS

This Reply is responsive to the final Office Action[1] of March 5, 2009. Claims 1-7 and 9-18 were presented for examination and were rejected. No claims are amended, canceled or added. Claims 1, 9, 11, 16 and 17 are in independent form. Claims 1-7 and 9-18 are pending. Claim 8 was previously canceled without prejudice or disclaimer.

Claims 11 and 13-15 are rejected under 35 U.S.C. § 102(e) as being anticipated by *Burnstein* et al. (U.S. 2002/0032735 A1; hereinafter "*Burnstein*"). *Claims 1-7, 9, 12, 16 and 18* are rejected under 35 U.S.C. § 103(a) as being un-patentable over *Burnstein* in view of *Munsil* et al., U.S. Patent 5,761,650 (hereinafter, "*Munsil*"). *Claims 10 and 17* are rejected under 35 U.S.C. § 103(a) as being un-patentable over *Burnstein* in view of *Munsil* and further in view of *Carter* et al., (U.S. 2005/0068983 A1; hereinafter "*Carter*"). These rejections are respectfully traversed because the references, taken individually or in any reasonable combination, do not disclose or suggest all recited claim elements of each pending claim for the following reasons.

In its 12/5/2008 response, Applicant added a "status message" limitation, among other limitations, which is discussed below with respect to each of its independent claims.

Independent claim 1:

Claim 1 is rejected under 35 U.S.C. § 103(a) as allegedly un-patentable over Burnstein and Munsil. Claim 1 recites, *inter alia*: "sending a generated status message

---

[1] The Office Action may contain a number of statements characterizing the cited references and/or the claims which Applicant may not expressly identify herein. Regardless of whether or not any such statement is identified herein, Applicant does not automatically subscribe to, or acquiesce in, any such statement.

to said other customers, if said COI exists, as confirmation that said one customer _has joined said COI_." (emphasis added) Burnstein, paragraph 16, is cited against this limitation (Office Action, page 5)

> [0016] The problem is that there typically needs to be a critical mass of 5-500 users to provide enough people to cover a wide range of questions that might be asked on any given topic. This invention only requires that there be as little as two people who have a similar interest. Even if the earlier searcher is not currently looking for information on this subject this invention "remembers" his or her [previously-expressed] interest and automatically asks permission [of the earlier searcher] to make a match with someone who is interested.

(Burnstein, paragraph 16, emphasis added) Clearly, Applicant's recited limitation calls for "confirmation that said one customer has joined said COI" and this is a confirmation of a deed that has taken place. This is confirmation of an accomplished deed. Note the usage of past tense in the term "has joined" which is recited in the claim.

But, quite differently, the passage in Burnstein cited against this limitation, namely, "asks permission [of the earlier searcher who had previously expressed interest] to make a match with someone who is interested" clearly refers to an event that might take place in the future. Perhaps, this person who is interested shall eventually join and perhaps not. For example, suppose the "earlier searcher" refuses permission for whatever reason. In that case, the person who is interested shall not have joined. Indeed, to ask permission of "the earlier searcher" to make a match with "someone [else] who is interested" is merely making a request to join and is certainly _not_ a confirmation of a deed that has already taken place - it is not a "confirmation that said one customer has joined said COI" as recited in claim 1. Because asking permission to join is not a confirmation that the customer has joined, Burnstein does not disclose or suggest the

subject matter recited in claim 1. Neither Munsil, cited against claim 1 to show billing statements, nor Carter, cited against claims other than claim 1 to show randomly-generated alias names, cure this deficiency in Burnstein. Accordingly, Burnstein, Munsil and Carter, taken individually or in any reasonable combination do not disclose or suggest the subject matter recited in claim 1. For at least this reason, the 35 U.S.C § 103 (a) rejection of claim 1 should be withdrawn and the claim allowed.

Independent Claim 9:

Claim 9 is rejected under 35 U.S.C. § 103(a) as allegedly un-patentable over Burnstein and Munsil. Claim 9 recites, *inter alia*: "means for sending a generated status message to said other customers as confirmation that said one customer *has joined said COI*." (emphasis added) Burnstein, paragraph 16, is cited against this limitation (Office Action, page 5) Claim 9 is allowable for the same reasons as, or similar reasons to, those provided above with respect to claim 1.

Independent Claim 11:

Claim 11 is rejected under 35 U.S.C. § 102 as allegedly anticipated by Burnstein. Claim 11 recites, *inter alia*: "wherein…. a status message is generated and sent to said certain customers as confirmation that said at least one inquiring customer *has joined said COI*." (emphasis added) Burnstein, paragraph 16, is cited against this limitation (Office Action, page 3) Claim 11 is allowable for the same reasons as, or similar reasons to, those provided above with respect to claim 1.

Independent Claim 16:

Claim 16 is rejected under 35 U.S.C. § 103(a) as allegedly un-patentable over

Burnstein and Munsil. Claim 16 recites, *inter alia*: "allowing a generated status message

to be sent to said customer as confirmation that said customer has successfully created

said un-displayed topic of interest and *has joined said new group*" (emphasis added)

Burnstein, paragraphs 22 and 23 are cited against this limitation (Office Action, page 8):

> [0022] The initial interaction of the user with the computer or phone is to search for data.
> In the present embodiment of the invention, the data could be located on the computer
> itself, in distributed databases over a network connection, e.g., the Internet, intranet,
> extranet or over a telephone system. The user performs a search utilizing natural language
> consisting of a series of keywords, phrases, or sentences, called a "search string." Other
> types of search strings or search input are possible. The computer has means to pass the
> search string or search input to a search engine, which could be located on the computer
> itself or remotely on the network.

> [0023] The invention will take people matched by their search string or voice in/out and
> if it finds a match offer them the opportunity to enter an existing community or create a
> new community. This will be a text, avatar (graphical representation) or voice chat room
> for instant or real-time conversation via text or speech. There could be a "bulletin board"
> for posting asynchronous communication. The community might contain useful links to
> information, goods and services. The community will provide users with user preferences
> to control the look, feel and functionality of the community. For example users may not
> want a chat room and only want a bulletin board. Users may or may not want to shop
> from a community. Users may or may not want the community to suggest links to
> information, goods and services. The invention gives users control over these details.

(Burnstein, paragraphs 22 and 23, emphasis added) The Office Action, pg 8, states:

"Para 0022-0023, invitation to join or start new community sent to user if no matching

community found; Figs. 1-9." Applicant submits that there is nothing in this statement

and/or in Figs. 1-9 and nothing in Burnstein's paragraphs 22 and 23 which read on

"allowing a generated status message to be sent to said customer as confirmation that said

customer has successfully created said un-displayed topic of interest and *has joined said*

new group" as recited in claim 16 (emphasis added). Merely offering an opportunity *to*

enter into an existing community or *to* create a new community refers to an event that

might or might not take place in the future and, therefore, is not a status message confirming anything that has already taken place in the past. Therefore, Burnstein does not disclose or suggest the subject matter of claim 16. Munsil, cited to teach billing statements, does not cure this deficiency in Burnstein. Therefore Burnstein and Munsil, taken individually or in any reasonable combination do not disclose or suggest the subject matter of claim 16.

The Office Action has not cited Burnstein's paragraph 16 against this limitation and Applicant agrees that it should not be cited. But, even if the Office Action had done so, any rejection based on that cite would have been ineffective for reasons that are the same as, or similar to, those given above for claim 1.

For at least these reasons, the 35 U.S.C § 103 (a) rejection of claim 16 should be withdrawn and the claim allowed.

Independent claim 17:

Claim 17 is rejected under 35 U.S.C. § 103(a) as allegedly un-patentable over Burnstein and Munsil and Carter. Claim 17 recites, *inter alia*: (a) "sending, if said COI exists, a generated status message to others of said subset who belong to said COI as confirmation that said inquiring customer *has joined said COI*;" and (b) "sending, if said COI does not exist, a different generated status message to said inquiring customer signifying that said inquiring customer *has successfully joined a new COI*." (emphasis added)[2] Burnstein, paragraph 16 is cited against the (a) limitation and paragraphs 22 and 23 are cited against

---

[2] Note that "(a)" and "(b)" are designators used only in these remarks as convenient flags for discussion purposes.

the (b) limitation (Office Action, page 8) The (a) limitation recites "has joined said COI" and the (b) limitation recites "has successfully joined a new COI" both of which are past events and referred to in the past tense. They are not disclosed or suggested by their respectively cited passages in Burnstein for reasons that are the same as, or similar to, those given above with respect to claims 1 and 16, respectively. For at least these reasons, the 35 U.S.C § 103 (a) rejection of claim 17 should be withdrawn and the claim allowed.

All pending dependent claims are allowable, at least for reasons based on their respective dependencies from allowable base claims.

Although Applicant has focused above only on certain limitations that relate to a status message, Applicant does not acquiesce in the rejections presented in the Office Action for other reasons. Applicant believes that Burnstein also fails as an effective teaching reference with respect to Applicant's recited subject matter because it is being improperly interpreted and applied.

Burnstein's providing a search ability is not equivalent to Applicant's sending a questionnaire and Burnstein's inputting search strings is not equivalent to Applicant's completing and submitting the questionnaire.

Applicant respectfully disagrees with the Examiner's position as expressed, for example, on pages 2-3 of the Office Action. Therein, when referring to Burnstein, Figs. 6-10, it says "providing search ability and receiving search string information is *equivalent* to sending a questionnaire and receiving responses - in both cases data is receive [sic] to correlate users." (emphasis added) But, receiving data (the subject to be

searched) to correlate users because <u>Burnstein's receiver</u> of that data (the search service/engine) wants to correlate users is <u>not</u> equivalent to receiving data to correlate users because <u>Applicant's supplier</u> of that data wants to correlate users. Burnstein says: "After making a match the invention automatically invites the matched parties to join a frictionless and immediate electronic community *if they so desire*." (Burnstein, paragraph 13) Thus, a received search string in Burnstein carries with it a question about whether it is acceptable subject matter for discussion within the electronic community but, quite differently, information supplied in response to Applicant's questionnaire is pre-approved by the supplier for community discussion because that is why it is being supplied in the first place.

In other words, in Burnstein, after a search request is made, the searching party receives, and possibly is surprised or even annoyed, with an invitation to join a group whose members have also searched the same topic. The searching party may refuse. Not every subject is a candidate for discussion for every searching party. Some subjects may be very private/sensitive to some individuals under certain circumstances. This is quite different from receiving a questionnaire, as Applicant discusses, to be voluntarily answered by a party who knows in advance that he/she is attempting to join a discussion group about a subject(s) of interest and who wants to discuss that subject. Common data does not necessarily imply a mutual interest in the parties submitting that common data to discuss it. That is why Burnstein offers the option of not joining a COI: i.e., "if they so desire" as noted above. However, Applicant's questionnaire, which is to be affirmatively completed only if the participant wants to participate in a discussion of a particular subject noted in the questionnaire, is quite different, *ab initio*, from a search request.

Thus, contrary to the Examiner's interpretation, Burnstein's teaching of search ability is not equivalent to Applicant's teaching of sending a questionnaire and Burnstein's teaching of receiving search string information is not equivalent to Applicant's teaching of responding to the questionnaire.

Burnstein's search string shall not express a range of interests equivalent to those which can be expressed in a response to a questionnaire designed to elicit, *inter alia*, subjects of interest appropriate for community discussion.

Considering Burnstein from a different perspective, its search string teaching again lacks equivalence to Applicant's questionnaire response. Applicant submits that people ordinarily do not search all subjects in which they have interest. A search of a particular subject is conducted for a particular reason and a search string is focused on a specific topic. Therefore a large segment of subject matter of interest to an individual shall probably remain undisclosed and not inquired about, in accordance with the teachings of Burnstein, when using that individual's search string as the basis for inquiring about his/her interest in joining a community of interest (COI).

By contrast, when presenting a questionnaire, in accordance with Applicant's disclosure, a wide-ranging inquiry about subject matter of interest can be presented to that individual who is not restricted in his/her response. Thus, subjects in a wide spectrum and unrelated to each other can emerge responsive to a questionnaire, as compared to a mere subset of those subjects, if not only one subject, that would be submitted for a search. Accordingly, Applicant can offer a basis for chatting with others on virtually all non-private subjects of current interest to that individual while Burnstein does not. This example underscores the fact that the search string information and the

questionnaire responses *are not equivalent* mechanisms for setting up communities of interest for conversation or interaction.
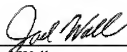
Therefore, in addition to the status message argument given above for allowability of the claims, which is independent of this instant questionnaire discussion, Applicant contends that Burnstein is not an effective reference because a *questionnaire* is not disclosed or suggested in Burnstein in the first place. The searching technique disclosed in Burnstein is not reasonably equivalent to a questionnaire. Therefore, the pending claims are allowable for this reason as well.

CONCLUSION

All rejections in the Office Action have been addressed. In view of the foregoing remarks, reconsideration and allowance of the pending claims are respectfully requested.[3]

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-2347 and please credit any excess fees to such deposit account.

Respectfully submitted,

By: _____

Joel Wall
Reg. No. 25,648

Date: May 26, 2009
Verizon
Patent Management Group
1515 Courthouse Road, Suite 500
Arlington, VA 22201-2909
Tel: 703.351.3586
CUSTOMER NO. 25,537

---

[3] Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such assertions/requirements in the future.